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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,985	03/30/2001	Kenichiro Yamauchi	MTS-3231US	9159
7590		11/16/2005	EXAMINER	
Allan Ratner		CHEVALIER, ROBERT		
Ratner & Prestia		ART UNIT		
One Westlakes, Berwyn, Suite 301		PAPER NUMBER		
P.O. Box 980		2616		
Valley Forge, PA 19482-0980		DATE MAILED: 11/16/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,985

Applicant(s)

YAMAUCHI ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 4, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is not limited to a single paragraph, and furthermore, the abstract contains the term "means". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 12-13, and 15, are rejected under 35 U.S.C. 101 because the claim is directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming

nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, and 10-16, are rejected under 35 U.S.C. 102(b) as being anticipated by Lane et al.

Lane et al discloses an video/audio recording/reproducing apparatus that shows all the limitations recited in claims 1, and 16, including the feature of inputting/receiving multiple MPEG transport streams (See Lane et al's Figure 10a, component 206), the feature of generating special reproduction data by selecting a transport packet including data of a predetermined kind of frame from transport packets of the MPEG transport stream, without converting the inputted MPEG transport stream to an CS (elementary stream) or PES and (packetized elementary stream) (See Lane et al's Figure 10a, component 308, and column 50, lines 49-56), and the feature of outputting the special reproduction data as an MPEG transport stream as specified in the present claims 1, and 16. (See the trick play data outputted for recording purposes as shown in Lane et al's Figure 10a, component 312 and 314).

With regard to claims 10-11, the feature of the predetermined frame being I frame as specified thereof is present in Lane et al. (See the special reproduction data generated in Lane et al's Figure 10a, component 308).

With regard to claims 12-15, the feature of the medium having recorded thereon the generated special reproduction data as specified thereof is present in Lane et al. (See Lane et al's Figure 10a, component 340).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2-3, 5-6, 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al in view of the submitted prior art of Hurst (EP 0897245).

Lane et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 2-3, and 8, including the feature of generating special reproduction data as specified in the present claims 2-3, and 8. (See Lane et al's Figure 10a, component 308).

Although Lane et al discloses the capability of correcting errors in the generated special reproduction data, it is noted, however, that Lane et al fails to specifically disclose the feature of adding Presentation Time Stamp or decoding time stamp, which is used for special reproduction, to the selected transport packet, and corrects a mismatching MPEG format so as to generate the special reproduction data as specified in the present claims 2-3, and 8.

The submitted prior art of Hurst (EP 0897245) discloses the capability of generating special reproduction data and the capability of adding Presentation Time Stamp or Decoding Time Stamp, which is used for special reproduction, to the selected transport packet, and corrects a mismatching MPEG format so as to generate the special reproduction data as specified in the present claims 2-3, and 8. (See Hurst's page 4).

It would have been obvious to one skilled in the art to modify the Lane et al's recording/reproducing apparatus wherein the error correcting means provided thereof (See Lane et al's Figure 10a, component 310) would incorporate the capability of adding Presentation Time Stamp or Decoding Time Stamp, which is used for special reproduction, to the selected transport packet, and corrects a mismatching MPEG format so as to generate the special reproduction data in the same conventional manner

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as is shown by Hurst. The motivation is to increase the performance of the error correcting means, thereby, increase the quality of the generated video data as suggested by Hurst.

With regard to claims 5-6, the feature of the padding byte or dummy data recited thereof would be present in the proposed combination indicated above. (See Hurst's page 4, paragraph [0026], to page 5, paragraph [0028]).

10. Claims 4, 7, and 9, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
November 13, 2005.


ROBERT CHEVALIER
PRIMARY EXAMINER